

## UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office

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FILING DATE SERIAL NUMBER FIRST NAMED INVENTOR ATTORNEY DOCKET NO. 09/17/96 SHARKEY 08/714,987 17616-705 EXAMINER QM41/0402 PAUL DAVIS ART UNIT PAPER NUMBER WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO CA 94034 3739 DATE MAILED: 04/02/99 This is a communication from the examiner in charge of your application. COMMISSIONER OF PATENTS AND TRADEMARKS Doemhh 27, A shortened statutory period for response to this action is set to expire. month(s), \_\_\_\_\_ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133 THE FOLLOWING ATTACHMENT(8) ARE PART OF THIS ACTION: Notice of References Cited by Examiner, PTO-892. 2. D Notice re Patent Drawing, PTO-948. Notice of Art Cited by Applicant, PTO-1449. 4.  $\square$  Notice of informal Patent Application, Form PTO-152. 6. 🗆 SUMMARY OF ACTION 1. 1 Claims\_\_ 1-44 Of the above, claims 30-44 are withdrawn from consideration. 2. Claims 3. Claims \_ Claims 6. Claims ... are subject to restriction or election requirement. 7. 🔲 This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes. ☐ The corrected or substitute drawings have been received on \_ . Under 37 C.F.R. 1.84 these drawings are acceptable. acceptable (see explanation or Notice re Patent Drawing, PTO-948). 10.  $\square$  The proposed additional or substitute sheet(s) of drawings, filed on . \_\_\_ has (have) been 🔲 approved by the examiner. disapproved by the examiner (see explanation). 11.  $\square$  The proposed drawing correction, filed on  $\_$ \_\_\_\_, has been approved. disapproved (see explanation). 12.  $\Box$  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  $\Box$  been received  $\Box$  not been received been filed in parent application, serial no. . 13. 

Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. 14. Other

EXAMINER'S ACTION

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Claims 30-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 5.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower or Schibora.

Edwards et al in combination with Ishikora et al. Makower and Edwards et al teach a device such as claimed except the blunt periphery, the use of platinum, band type sensor, thermistor type sensors, resistive heater or the use of potting compound. Ishikora et al teach the equivalence of blunt and pointed peripheries. It would have been obvious to the artisan of ordinary skill to employ a blunt periphery in the devices of Makower or Edwards et al, since these can function similarly and to employ the sensors, heaters, electrode material, sensor location and potting compound fixation, since these are not critical, provide no unexpected result and are notorious throughout the art for performing these functions, official notice of which has been taken, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29 are rejected under the judicially created doctrine of double patenting over claims 1-22 of U. S. Patent No. 5,458,596 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: all claimed subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant notes that Makower is intended to be used which puncturing tissue, there is nothing in the <u>structure</u> of <u>Makower</u> (or Edwards) that <u>prevents</u> it from being used without penetrating the surface of the selected site.

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Applicants arguments are noted, but are drawn to the way in which the device is used, rather than the <u>structure</u> thereof and as such are not convincing.

Applicant's arguments filed October 9, 1998 have been fully considered but they are not persuasive.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

DAVID M. SHAY PRIMARY EXAMINER GROUP 330

D.Shay:kst March 30, 1999